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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,451

07/18/2007

Domenico Fanara

06-796

9142

20306

7590

09/27/2010

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EXAMINER

THOMAS, TIMOTHY P

ART UNIT

PAPER NUMBER

1628

MAIL DATE

DELIVERY MODE

09/27/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/599,451</p>	<p>Applicant(s) FANARA ET AL.</p>	
	<p>Examiner TIMOTHY P. THOMAS</p>	<p>Art Unit 1628</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 September 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,5,12,17 and 27.
Claim(s) withdrawn from consideration: 6-10,14,15 and 18-26.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 9/3/2010; 9/21/2010
13. ☒ Other: See Continuation Sheet.

/Timothy P Thomas/
Examiner, Art Unit 1628

Continuation of 3. NOTE: The amended claim limitations of claim 1 are both new limitations that require further consideration and search.

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1-2, 5, 12, 17 and 27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over DeLongueville et al. (WO 02/47689 A2; cited in a prior Office Action); Gilliland et al. (Gilliland 1) ("The bactericidal activity of a methyl and propyl parabens combination: isothermal and non-isothermal studies"; 1992; Journal of Applied Bacteriology; 72: 252-257; cited in a prior Office Action); Gilliland et al. (Gilliland 2) ("Kinetic evaluation of claimed synergistic paraben combinations using a factorial design"; 1992; Journal of Applied Bacteriology; 72: 258-261; cited in a prior Office Action); and Doron et al. ("Antibacterial effect of parabens against planktonic and biofilm Streptococcus sobrinus"; 2001 International Journal of Antimicrobial Agents; 18: 575-578; cited in a prior Office Action); in view of Routledge et al. ("Some Alkyl Hydroxy Benzoate Preservatives (Parabens) Are Estrogenic"; 1998; Toxicology and Applied Pharmacology; 153: 12-19; cited in a prior Office Action).

The rejection is maintained for the reasons of record.

Applicant argues that unexpected findings that a pharmaceutical composition comprising levocetirizine and a reduced amounts of preservatives, such as parabens is stable, i.e., resistant to microbial contamination, for a long period of time; that the low amount of parabens without additional preservatives in a liquid pharmaceutical composition comprising levocetirizine would be sufficiently antimicrobial was unpredictable from the prior art. The rejection of record establishes an expectation of antimicrobial activity when the elected components are present. The record indicates that some results for an unexpected result have been disclosed; however, those results are not commensurate in scope with the claims (see discussion in Final Office Action, mailed 7/27/2010).

Applicant further argues surprising results, that levocetirizine itself has the property of a preservative. Even so, preservative activity is expected from the composition, based on the added parabens, known to be preservatives. The demonstration of unexpected results is not commensurate in scope with the instant claims.

Applicant argues that Doron teaches ratios of MP:PP approaching those recited in the present claims, but at a much higher concentration levels than are used in the present invention; that Doron relates to an oral rinse solution intended to destroy streptococcus bacteria on oral surfaces; that it does not relate to the issues of repeated contact of a dosing implement that can introduce bacteria to the solution, nor does it address the issue of planktonic bacteria. The claims do not recited limitations associated with these arguments; only a liquid pharmaceutical composition containing specific ingredients, with some amount and ratio limitations. The record indicates reduced bacterial counts have been demonstrated, even at 0.9 mg/ml total paraben.

Applicant argues that Doron does not teach or suggest that the presently claimed upper limit of 1.125 mg/g total paraben can be effective against planktonic bacteria. Planktonic bacteria is not a limitation recited in the claims; indeed 0.9 mg/ml total paraben has been established as having reduced bacterial counts.

Applicant argues that the data of Figure 2 require 1.55 mg/ml (0.155%) total parabens to achieve zero planktonic bacteria growth; therefore, this data teaches away from the claimed invention. This is not persuasive; lower levels of total parabens, including the value of 0.9, have been established reducing bacterial counts.

Applicant argues that Guillard 2 used the lowest total paraben amount of 0.132 w/v (about 1.32 mg/ml) which is 17% greater than the recited maximum; that the present invention has shown that a maximum dosage level significantly lower than Guillard's lowest and ineffective dosage level is effective as a preservative for levocetirizine solution, due to the surprising and heretofore unappreciated preservative effects of the levocetirizine itself. It has been acknowledged that there is data present in the specification demonstrating unexpected results over the comparative solutions. However, for the reasons discussed on the record, this data is not commensurate in scope with the instant claims. Doron establishes 0.9 mg/ml total parabens has activity in reducing bacterial counts, rendering this amount obvious in the instant claimed formulations.

Applicant argues that the obviousness that the use of lower amounts of a 9/1 ratio is suggested by the largest antimicrobial activity taught by Doron taken together with the ratios of Guillard 2 would employ amounts of parabens 17-37% greater than the maximum amount presently claimed; that these references do not teach or suggest the amount of parabens required by claim 1. This is not persuasive. 0.9 mg/ml is established to be an amount that reduces bacterial counts, motivating the use of amounts in this range, especially when a 9/1 ratio is clearly synergistic.

Applicant's arguments with respect to amended claim limitations are not relevant, because the claims have not been entered..

Continuation of 13. Other: The 9/21/2010 IDS has not been considered; there no statement required under 37 CFR 1.97 e (1) or (2) and there is no fee, both of which are required after final; see MPEP 609.04(b) (III), which states that both (A) and (B) are required after a final Office Action.